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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/807,235	06/15/2001	Joerg Schwenk	2345/150	3132

26646 7590 12/31/2007  
KENYON & KENYON LLP  
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EXAMINER
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KLIMACH, PAULA W

ART UNIT	PAPER NUMBER
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2135

MAIL DATE	DELIVERY MODE
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12/31/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

09/807,235

**Applicant(s)**

SCHWENK ET AL.

**Examiner**

Paula W. Klimach

**Art Unit**

2135

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 4-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 4-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/31/07 has been entered.

### ***Response to Arguments***

Applicant's arguments filed 10/31/07 have been fully considered but they are not persuasive because of following reasons.

Applicant argued that neither Fridrich nor Wong teach the limitation that are added in the amendment. This found persuasive. The newly cited reference teaches the missing limitation.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 4-6, and 9** are rejected under 35 U.S.C. 103(a) as being unpatentable over Fridrich (6,101,602) in view of Wong (6,504,941 B2) and further in view of Rodriguez et al. (2004/0263911 A1).

*In reference to claims 4 and 9*, Fridrich discloses a method and system for authenticating using a watermark (abstract). The method comprises generating digital watermarks electronic documents, where the owner of a document hides a digital watermark as proof of identity in the document (Fig. 3), prior to being hidden, the watermark being not only provided with the proof of identity id, but also at least with the hash value  $h(m)$  of the document (column 5 lines 59-61). Fridrich verifies (authenticates) ownership of the document by comparing the hash value of the document (column 6 line 65 to column 7 line 5).

Although Fridrich discloses the overlaid pattern depends on the key, Fridrich does not expressly disclose a secret key for making the watermark visible, characterized in that, to verify the true authorship, reversibly embedded watermarks are removed again with the assistance of the secret keys in order to restore the document to its original state, i.e., to check it on the basis of its hash values.

Wong discloses a method and system that provides an invisible watermark that may be used in public key or secret key watermark systems (abstract). The system of Wong disclose a secret key for making the watermark visible, characterized in that, to verify the true authorship, reversibly embedded watermarks are removed again with the assistance of the secret keys in order to restore the document to its original state, i.e., to check it on the basis of its hash values (Fig. 10 A in combination with column 2 line 59 to column 3 line 9).

Art Unit: 2135

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to associate a user key with a watermark as in Wong in the system of Fridrich. One of ordinary skill in the art would have been motivated to do this because it may be used as a method of ownership verification so that the desired watermark can only be extracted from a watermarked image with the appropriate user key (Wong column 1 lines 50-64).

Wong and Fridrich do not teach generating the watermark step includes generating the watermark as a function of the proof of identity identification, first hash value of the document, and an authentic time stamp.

Rodriguez discloses a method for using embedded auxiliary signals in documents for copy detection and other applications. Rodriguez discloses a system wherein the generating the watermark step includes generating the watermark as a function of the proof of identity identification (payee), the first hash value of the document (hash of data), and an authentic time stamp (date) (paragraph 0115).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to utilize the watermark as in Rodriguez in the system of Fridrich. One of ordinary skill in the art would have been motivated to do this because the watermarks may be used to identify documents and perform copy detection.

*In reference to claims 5*, characterized in that, prior being hidden, the digital watermark is not only provided with the proof of identity id, also with an authentic time stamp, which, besides the time value t, also contains at least the hash value of the document, and, in addition, defines the embedding sequence (column 6 line 65 to column 7 line 11).

Art Unit: 2135

*In reference to claim 6*, wherein the authentic time stamp defines an embedding sequence. Fridrich discloses the including the time stamp in the watermark (column 7 lines 1-5), therefore defining the embedding sequence because the time affects that watermark that is embedded.

**Claims 7-8 and 10** are rejected under 35 U.S.C. 103(a) as being unpatentable over Fridrich in view of Wong and further in view of Rodriguez as applied to claim 4 above, and further in view of Rhoads et al (6,636,615 B1).

*In reference to claim 7* Fridrich discloses using hash values to associate the digital watermark with a specific image and therefore use the hash value to determine the original owner (column 5 line 59 to column 6 line 3).

However neither Fridrich nor Wong disclose using multiple watermarks.

Rhoads discloses embedding several watermarks into the same image (Fig. 4 and column 5 lines 15-46). It follows that to restore the image to the original state all the different watermarks would have to be removed using the method disclosed by Wong.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to embed multiple watermarks as disclosed by Rhoads in the system of Fridrich. One of ordinary skill in the art would have been motivated to do this because multiple watermarks can be used to convey multiple sets of information.

*In reference to claim 8*, wherein the restoring step includes restoring the document to the original state by removing all of the different watermarks in accordance with an embedding sequence.

Although Rhoads discloses embedding multiple watermarks in the same image (Section 2 page 2068), Fridrich, Wong, and Rhoads do not expressly disclose restoring the document to the original state by removing all of the different watermarks.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to remove the multiple watermark to restore the document to the original form in the system of Fridrich. One of ordinary skill in the art would have been motivated to do this because the watermarks add noise to the image and therefore to restore the image to the original form the noise would need to be removed.

*In reference to claim 10* Fridrich discloses using hash values to associate the digital watermark with a specific image and therefore use the hash value to determine the original owner (column 5 line 59 to column 6 line 3).

However neither Fridrich nor Wong disclose using multiple watermarks.

Rhoads discloses embedding several watermarks into the same image (Fig. 4 and column 5 lines 15-46). It follows that to restore the image to the original state all the different watermarks would have to be removed using the method disclosed by Wong.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to embed multiple watermarks as disclosed by Rhoads in the system of Fridrich. One of ordinary skill in the art would have been motivated to do this because multiple watermarks can be used to convey multiple sets of information.

Although Rhoads discloses embedding multiple watermarks in the same image (Section 2 page 2068), Fridrich, Wong, and Rhoads do not expressly disclose restoring the document to the original state by removing all of the different watermarks.

Art Unit: 2135

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to remove the multiple watermark to restore the document to the original form in the system of Fridrich. One of ordinary skill in the art would have been motivated to do this because the watermarks add noise to the image and therefore to restore the image to the original form the noise would need to be removed.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paula W. Klimach whose telephone number is (571) 272-3854. The examiner can normally be reached on Mon to Thr 9:30 a.m to 5:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on (571) 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PWK  
Friday, December 21, 2007



**THANHNGA TRUONG  
PRIMARY EXAMINER**